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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER	
BOUTAH, ALINA A	

  

ART UNIT	PAPER NUMBER
2143	

  

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12/27/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 09/877,317	<b>Applicant(s)</b> SIE ET AL.	
	<b>Examiner</b> Alina N. Boutah	<b>Art Unit</b> 2143	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 10 October 2007.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 9-15 and 19-27 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 9-15 and 19-27 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Response to Amendment***

This action is in response to Applicant's amendment filed October 10, 2007. Claims 1-8 and 16-18 have been cancelled. Claims 22-27 have been newly added. Claims 9-15 and 19-27 are pending in the present application.

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on October 10, 2007 has been entered.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 19-21 and 25-27 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding independent claim 19, it is unclear as to what Applicant is intended by "period." It is assumed that it is referred to as a stagger period.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 9-15 and 19-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over USPN 5,729,280 issued to Inoue et al.

Regarding claim 9, Inoue teaches a method for receiving a program by a user location that is sent from a remote provider, the method comprising steps of:

recording any first segment of each of the plurality of programs that are not already stored (col. 8, lines 35-62: recording remaining segments of program);

detecting the user request for one of the plurality of programs (col. 8, lines 35-62: user directing programs to be pre-recorded); and

recording a second segment of the one of the plurality of programs in response to the detecting step (col. 8, lines 35-62: recording pre-storage of the video program as directed by user).

Although Inoue does not explicitly teach determining if any of a first segment of each of a plurality of programs sent from the content provider before any user request for any of the plurality of programs are not already stored, it would have been obvious to one of ordinary skill in the art to determine if any of a first segment of a program is not already stored and recording a segment that is not already stored because doing so will allow only segments that are needed to be recorded, thus saving storage space.

Regarding claim 10, Inoue teaches the method for receiving the program by the user location that is sent from the remote provider as recited in claim 9, further comprising a step of recording any remaining segments of the one of the plurality of programs (col. 8, lines 35-62).

Regarding claim 11, Inoue teaches the method for receiving the program by the user location that is sent from the remote provider as recited in claim 9, wherein the first segment and the second segment are on different digital channels (figure 2).

Regarding claim 12, Inoue teaches the method for receiving the program by the user location that is sent from the remote provider as recited in claim 9, wherein the first segment and the second segment are on different transponders (figure 1).

Regarding claim 13, Inoue teaches the method for receiving the program by the user location that is sent from the remote provider as recited in claim 9, further comprising a step of playing the one of the plurality of programs (abstract).

Regarding claim 14, although Inoue does not explicitly teaches the method for receiving the program by the user location that is sent from the remote provider as recited in claim 9, wherein the detecting step comprises steps of: receiving a wireless request from a remote control; and processing the wireless request to determine a desired program, he teaches receiving request from user's controlling device, which in this case could be wired or wireless (col. 2, line 58 to col. 3, line 13).

Regarding claim 15, Inoue teaches the method for receiving the program by the user location that is sent from the remote provider as recited in claim 9, wherein the first listed recording step comprises a step of recording the first segment on a mass storage device associated with a set top box that is proximate to the user location (figure 1).

Regarding claim 19 (amended), Inoue teaches a method for receiving a program by a user location that is sent from a content provider, the method comprising steps of:

recording a first segment of a plurality of the programs sent from the content provider before any user request for the program (col. 8, lines 35-62: pre-stored program; col. 9, lines 31-38 – pre-storing preview clips; figures 4A-4B: pre-storing programs a-e);

detecting the user request for selected program of the plurality of programs (col. 6, lines 14-24: user requests that program be received); and

recording a second segment of the selected program if the user request is detected before a period expires wherein the period is less than a duration of the program (col. 8, lines 35-62: recording the rest of the program; figure 4A – user's request is detected at T6 before a period (of 5 mins) is expired, channel 3 records program a3).

Although Inoue does not necessarily teach recording a first segment of all of the plurality of programs, he teaches recording a plurality of programs as cited above. One of ordinary skill in the art would have recognized that this is an obvious variation of Inoue. It would have been obvious to record all programs in order to allow users to view all of available contents, thus giving user more choices.

Regarding claim 20, Inoue teaches the method for receiving the program by the user location that is sent from the content provider as recited in claim 19, wherein the detecting step comprises a step of detecting the user request for the program during the step of recording the first segment (col. 8, lines 35-62).

Regarding claim 21, Inoue teaches the method for receiving the program by the user location that is sent from the content provider as recited in claim 19, wherein the recording steps comprise a step of recording on a rotating disk at the user location (col. 4, lines 36-46).

Regarding claims 22 and 25, Inoue teaches wherein the first segment of each of the plurality of programs is sent from the content provider once (figure 4A).

Regarding claims 23 and 26, Inoue teaches wherein the first segment of each of the plurality of programs are sent from the content provider on the same channel (figure 4A).

Regarding claims 24 and 27, Inoue teaches wherein the second segment of the selected program is sent from the content provider more than once and on more than one channel (figure 4A).

### ***Response to Arguments***

Applicant's arguments have been fully considered but they are not persuasive.

In response to Applicant's argument in claim 9 that Inoue fails to teach "determining if any of a first segment of each of a plurality of programs sent from the content provider before any user request for any of the plurality of programs are not already stored," as argued above, this feature would have been obvious to one of ordinary skill in the art. Specifically, it would



make sense to detect a program that is stored and record only the program that is not already stored in order to allow only segment of programs that are needed to be recorded, thus saving storage space.

Regarding claim 19, Applicant argues that Inoue fails to teach “recording a first segment of all a plurality of programs sent from the content provider before any user request for the program,” as stated above in the rejection, Inoue teaches recording a first segment of a plurality of programs sent from the content provider, but not necessarily all of the program. One of ordinary skill in the art would recognize that this is an obvious variation of the teaching of Inoue. It would have been obvious to record all of programs as opposed to some in order to provide all of the programs to the user, thus allowing the user more selection choices.

Regarding newly added claims, Inoue, in figure 4A for example teaches that the first segment of each of the plurality of programs is sent from the content provider once, on the same channel, and the second segment of the selected program is sent from the content provider more than once and on more than one channel.

### ***Conclusion***

It is noted that the column, line, and/or page number citations used in the prior art references as applied by the Examiner to the claimed invention are for the convenience of the Applicant to represent the relevant teachings of the prior art. The prior art references may contain further teachings and/or suggestions that may further distinguish the citations applied to the claims, therefore, the Applicant should consider the entirety of these prior art references during the process of responding to this Office Action. It is further noted that any alternative and non-

preferred embodiments as taught and/or suggested within the prior art references also constitute prior art and the prior art references may be relied upon for all the teachings would have reasonably suggested to one of ordinary skill in the art. See MPEP 2123.

The prior art listed in the PT0-892 form included with this Office Action disclose methods, systems, and apparatus similar to those claimed and recited in the specification. The Examiner has cited these references to evidence the level and/or knowledge of one of ordinary skill in the art at the time the invention was made, to provide support for universal facts and the technical reasoning for the rejections made in this Office Action including the Examiner's broadest reasonable interpretation of the claims as required by MPEP 2111 and to evidence the plain meaning of any terms not defined in the specification that are interpreted by the Examiner in accordance with MPEP 2111.01. The Applicant should consider these cited references when preparing a response to this Office Action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alina N. Boutah whose telephone number is 571-272-3908. The examiner can normally be reached on Monday-Friday (9:00 am - 5:00 pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nathan Flynn can be reached on 571-272-1915. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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AU 2143